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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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THE POLKINGHORNS 9003 FLORIN WAY UPPER MARLBORO, MD 20772				
EXAMINER PEYTON, TAMMARA R				
ART UNIT PAPER NUMBER				
2182 6				

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/084,226	MORAN, DOV	
	Examiner	Art Unit	
	Tammara R Peyton	2182	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6, 16, 19, 24 rejected under 35 U.S.C. 102(e) as being anticipated by *Eichstaedt et al.*, (US 6,563,494).

As per claims 1, 16, 19, and 24, *Eichstaedt* teaches a portable device (44, Fig.1,2) only for data storage and transfer for a user, comprising:

a non-volatile memory (data store, 52, Fig. 2) for storing the data, wherein data transfer with said non-volatile memory is controlled according to at least one instruction

(inherent in processor, 48, Fig.2), wherein said at least one instruction is not alterable by the user;

a logic (inherent in processor, 48) or executing said at least one instruction; and
a device interface (50, Fig. 2, transceiver) for enabling the data to be transferred from the portable device directly to another portable device (PDA, 12 or 14, Fig.1), wherein communication between said portable devices only occurs through respective device interfaces. (Abstract, col. 1, lines 49-col. 6)

Eichstaedt teaches a portable stylus that is used for data storage. The portable stylus includes a data store (memory), processor (logic), and transceiver (device interface). It would be inherent that the one instruction not alterable by the user would be the instructions executed by processor that enable the stylus to received and stored data. *Eichstaedt* teaches that portable stylus is able to transfer data directly to another portable device. For example, the portable stylus may receive data from PDA 12 and transfer the received data back to PDA 12, or the portable stylus may have other data stored in the data storage and transfer that other data to another device like PDA 14.

As per claim 2, *Eichstaedt* teaches wherein direct transfer of the data is not performed through a computer, such that a plurality of portable devices are capable of communicating directly through respective device interfaces.

As per claim 4, *Eichstaedt* teaches wherein said logic is a microprocessor and wherein said at least one instruction is stored on said non-volatile memory.

As per claim 5, *Eichstaedt* teaches wherein the portable device does not feature a user interface for communicating directly with a user.

As per claim 6, *Eichstaedt* teaches further comprising a signaling device for transmitting a signal to another portable device, said signal requesting transfer of data.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16, 23, and 24, are rejected under 35 U.S.C. 102(e) as being anticipated by *Eberhard et al.*, (US 2003/0056131)

As per claims 16, 23, and 24, *Eberhard* teaches a portable device for data storage, comprising:

a non-volatile memory (124, Fig. 1) for storing the data;

a device interface (112, Fig. 1) for interfacing the device with a second portable device (PDA, 150, Fig.1) for transferring data, wherein data is only transferable through said device interface;

a mechanism for transferring the data between the device and said second portable device using said respective device interfaces of the device and said second portable device, such data transfer occurring directly between the device and said second portable device without passing the data through an additional device and wherein said mechanism is not alterable. (Abstract, pgs. 1-5)

Eberhard teaches a portable laptop computer that is able to transfer data to and from a PDA without passing the data through an additional device and wherein the mechanism for transferring this data is unalterable.

Claims 1, 6-16, 19-25 are rejected under 35 U.S.C. 102(e) as being anticipated by *Dickie*, (US 2003/0041206).

As per claim 1, 6, and 7, *Dickie* teaches a portable device (104, Fig.1,4) only for data storage and transfer for a user, comprising:

a non-volatile memory (402, Fig. 4, pg. 2, [0025]) for storing the data, wherein data transfer with said non-volatile memory is controlled according to at least one instruction (inherent in processor, 400, Fig.4), wherein said at least one instruction is not alterable by the user;

a logic (inherent in processor, 400) or executing said at least one instruction; and
a device interface (404, Fig. 4) for enabling the data to be transferred from the portable device directly to another portable device (portable computer, 104, Fig.4), wherein communication between said portable devices only occurs through respective device interfaces. (Abstract, pgs. 1-3)

As per claims 16, 19, 23, and 24, *Dickie* teaches a portable device for data storage, comprising:

a non-volatile memory (402, Fig. 4) for storing the data;
a device interface (404, Fig. 4) for interfacing the device with a second portable device (portable computer, 104, Fig.4) for transferring data, wherein data is only transferable through said device interface;
a mechanism for transferring the data between the device and said second portable device using said respective device interfaces of the device and said second portable device, such data transfer occurring directly between the device and said second portable device without passing the data through an additional device and wherein said mechanism is not alterable. (Abstract, pgs. 1-3)

As per claim 20, *Dickie* teaches a method for automatic transfer of data, the data being stored in a portable storage device, the method comprising:

detecting an existence of a second portable storage device for transferring the data; (Step 502, Fig.5)

determining at least one condition being fulfilled for transferring the data (Step 504, 506, Fig.5); and

automatically (504-510, Fig.5) transferring data fulfilling said at least one condition between the portable storage device and said second portable device.

As per claim 8-12, and 21, *Dickie* teaches a data is marked according to type (new data not already stored in the second portable device) upon being stored in the portable storage device, and wherein said type determines whether a condition is fulfilled.

As per claim 13, *Dickie* teaches wherein said device interface includes a physical connector to another communication port.

As per claims 14 and 15, *Dickie* teaches wherein said non-volatile memory could be a flash memory or a type of RAM. (pg. 2, [0025])

As per claim 22, *Dickie* teaches wherein the data includes personal data, and wherein the user enters at least one criterion for determining whether a condition is fulfilled. (pg. 3, [0031])

As per claim 25, *Dickie* teaches a permanently writable memory device (ROM) for storing said at least one instruction, wherein said at least one instruction is permanently stored in said permanently writable memory device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 14, 15, 17, 18, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Eichstaedt et al.*, (US 6,563,494).

As per claims 17 and 18, *Eichstaedt* teaches that the portable stylus capable of data storage and transfer. One of ordinary skill would readily recognize that the portable stylus lacks an operating system that could perform other functions. Further, the only user interface that *Eichstaedt* teaches is the display module and the control surface, 58, that when depressed causes the processor to transmit data.

As per claim 26, *Eichstaedt* teaches that portable stylus is able to transfer data directly to another portable device. It would have been obvious to one of ordinary skill at the time the invention was made that the data storage of the portable stylus includes

instruction that would enable to portable stylus to perform the data transfer to and from another portable device. Also, nowhere in *Eichstaedt* is it taught that the portable stylus of capable of receiving an additional software application that will be executed by the portable stylus.

As per claim 3, 14, 15, 25, 27, 28, and 29, *Eichstaedt* teaches said logic is a processor, but does not expressly teach an additional memory component for storing said at least one instruction. However, it would have been obvious to one of ordinary skill that the data store by *Eichstaedt* would include an additional component, one part of the data store would be for storing the permanent instructions to be implemented by the processor to perform the data transfer mechanisms and another part of the data store would be used to receive and hold data that will be eventually transferred to another portable device. *Eichstaedt* would have been motivated to include in the data store additional memory space that would include other instructions in order to expand the flexibility of the portable stylus. Further, memory components consisting of a flash memory, RAM, SD-RAM, or D-RAM are well known in the art, thereby making use of one or all of these memory components obvious to one of ordinary skill.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (703) 306-5508. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin, can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231.

Faxes for Official/formal (After Final) communications or for informal or draft communications (please label "PROPOSED" or "DRAFT") sent to:

(703) 872-9306

Hand-delivered responses should be brought to:

Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).



Tammara Peyton

November 3, 2003